

## **REMARKS**

This Response is submitted in answer to the Office Action dated October 14, 2004, having a shortened statutory period ending January 14, 2005, extended to February 14, 2005. A one month extension of time for this response is believed to be necessary. A request for one month extension of time and a check in the amount of \$120.00 are enclosed herewith. No other fees are believed to be necessary; however, in the event an additional extension of time is required, that extension of time is hereby requested. Please charge any fees associated with any extension of time as well as any other fee necessary to further the prosecution of this application to **IBM CORPORATION DEPOSIT ACCOUNT No. 50-0563**.

### **Rejection under 35 U.S.C. § 102:**

In the present Office Action, Claims 1-3, 7-8, and 12-13 are rejected under 35 U.S.C. § 102(b) as being anticipated by *Pearce et al* (U.S. Patent No. 6,484,308 – hereinafter referenced as “*Pearce*”). After careful consideration of Examiner’s remarks, Applicants respectfully submit that Claims 1-3, 7-8, and 12-13 are not rendered unpatentable by *Pearce* and respectfully traverses Examiner’s rejection in view of the arguments submitted therein.

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 221 USPQ 385 (Fed. Cir. 1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983).

*Pearce* discloses a system and method of ensuring “that a disk drive that is inserted into a computer system while the operating system is active is the drive used to boot the operating system” (col. 2, lines 5-9). If the computer system determines that the disk drive currently inserted into the computer system is not the drive used to boot the operating system, the system and method disclosed in *Pearce* queries the user to determine if the disk drive has been changed and repeats the process until the disk drive used during boot time is re-inserted into the computer system (Figure 6).

Nothing in *Pearce* teaches or suggests “interrogating a boot device for password information” and “in response to the boot device supplying password information corresponding to that of a trusted boot device, booting the data processing system utilizing the boot device” (Claim 1). *Pearce* is distinguished from the language in Claim 1 because *Pearce* discloses a determination made to the character of the disk drive (original boot disk drive or another disk drive) *after* the booting of the computer system has completed, not before, as indicated in Claim 1. Therefore, *Pearce* in no way teaches or suggests the present invention.

In light of the preceding argument, Applicants believe that independent Claim 1, similar Claims 7 and 12 and all dependent claims are not anticipated by *Pearce*.

**Rejection under 35 U.S.C. § 103:**

In the present Office Action, Claims 4, 9, and 14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Pearce* in view of *Herzi et al* (U.S. Patent No. 6,353,885 – hereinafter referenced as “*Herzi*”). Nothing in *Pearce* in view of *Herzi* teaches or suggests “interrogating a plurality of boot devices in sequence according to a priority order until a boot device supplies password information corresponding to that of a trusted boot device” (Claim 4).

*Herzi* discloses a system and method of easily configuring a computer system BIOS firmware by utilizing a smart card (col. 4, lines 40-42). Also, *Herzi* discloses booting a computer system from user-defined sources, such as a removable hard disk drive, floppy drive, or optical drive, depending on the BIOS settings stored on the smart card (col. 5, lines 58-64). *Herzi* also discloses the booting of a computer system utilizing BIOS settings from a smart card after a user enters a personal identification number (PIN). However, nothing in *Herzi* teaches or suggests a “boot device suppl[y]ing password information corresponding to that of a trusted boot device” (Claim 4).

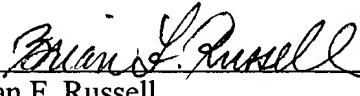
For example, the PIN requirement disclosed in *Herzi* differs in a variety of ways. The PIN is user-supplied as opposed to being supplied by a “boot device”, as indicated in Claim 4.

Also, the PIN as disclosed in *Herzi* secures the BIOS settings stored on the smart card, but does not identify a “trusted boot device”, as indicated in Claim 4. It is possible for an unauthorized person to know the PIN for the smart card and still compromise the computer system by installing a foreign hard disk drive into the computer system. The PIN query does not determine the character of the hard disk drive installed into the computer system. The PIN only protects the integrity of the BIOS settings stored on the smart card.

Accordingly, Applicants believe that the arguments applicable to Claim 4 also apply to similar Claims 9 and 14. Also, even if *Herzi* teaches or suggests the claimed element, the arguments applicable to Examiner’s rejection under § 102(b) also apply to Claims 4, 9, and 14 as dependent claims to independent Claims 1, 7, and 12.

Applicants invite the Examiner to contact the undersigned attorney of record at (512) 343-6116 if such would further or expedite the prosecution of the present Application.

Respectfully submitted,

  
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Brian F. Russell  
Reg. No. 40,796  
DILLON & YUDELL LLP  
8911 North Capital of Texas Highway  
Suite 2110  
Austin, Texas 78759  
Telephone (512) 343-6116  
Facsimile (512) 343-6446  
ATTORNEY FOR APPLICANTS